

REMARKS

Claims 1-20 remain in the application. Claims 1-20 have been amended.

Claims 1-20 have once again been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,681,998 to Nakazaki et al. in view of U.S. Patent No. 5,473,657 to McKenna. Claims 1-20 have been amended to more clearly define the present invention as being specifically directed to an improved gantry of a CT scanner including roller trucks which shift vibration frequencies of the rotating CT scanner to improve images produced by the CT scanner. Applicant respectfully traverses the obviousness rejection based on Nakazaki et al., because Nakazaki et al. is directed to a load measuring device for a vehicle (i.e., an automobile) and contains no suggestion of the desirability of the invention claimed (i.e., a CT scanner gantry having a roller truck) in the presently amended claims.

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.) The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

NAKAZAKI ET AL. CONTAINS NO SUGGESTION OF THE DESIRABILITY OF THE INVENTION CLAIMED IN THE PRESENTLY AMENDED CLAIMS

Nakazaki et al. is directed to a load measuring device for a vehicle, and more particularly, an improvement of a disposition of a strain gauge type sensor or the like used in the load

measurement of a vehicle, such as a truck. The strain gauge happens to be shown mounted on a leaf spring assembly of a vehicle, but Nakazaki et al. does not teach or suggest the benefits of a particular leaf spring assembly design, and that a particular leaf spring assembly design may reduce or shift the vibrations produced by the vehicle (e.g., vibration produced between a road and a moving vehicle, such as a truck).

Figs. 5-10 of the present application illustrate that an improved gantry according to the present invention provides shifted vibration frequencies and better CT images in comparison to a gantry U.S. Patent No. 5,473,657 to McKenna. However, there is no teaching, suggestion, or motivation in either of Nakazaki et al. or McKenna to apply the structures of Nakazaki et al. to the gantry of McKenna in order to shift vibration frequencies and provide better CT images. In fact, the words "vibration," "frequency," and "distortion" are not used anywhere in the text of Nakazaki et al.

The mere fact that Nakazaki et al. and McKenna can be combined does not render the resultant combination obvious unless those references also suggests the desirability of the combination. Since Nakazaki et al. does not suggest the desirability of the combination (e.g., no teaching or suggestion of vibration dampening), the combination of Nakazaki et al. and McKenna does not make the invention as presently claimed obvious.

On the basis of the foregoing amendments and remarks, the Applicants respectfully request that the patent office reconsider and withdraw the rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,681,998 to Nakazaki et al. in view of U.S. Patent No. 5,473,657 to McKenna. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

The Commissioner is hereby authorized to charge any additional fees that may be due in connection with the filing of this paper, or credit any overpayment, to Deposit Account No. 50-1133.

Date: 6-2-04

Respectfully submitted,



Jeffrey J. Miller
Registration Number 39,773
McDERMOTT, WILL & EMERY LLP
28 State Street
Boston, Massachusetts 02109
Tel.: (617) 535-4421
Fax: (617) 535-3800